

REMARKS

Claims 21-28 are pending. Reconsideration and allowance are respectfully requested.

Allowable Subject Matter

Claims 24-26 are indicated as being allowed.

Rejections under 35 U.S.C. §103(a)

Claims 21-23, 27, and 28 stand rejected under 35 U.S.C. §103(a) in view of Applicant Admitted Prior Art (“AAPA”), U.S. Patent No. 6,020,781 by Fuijoka (“Fuijoka”), and U.S. Patent No. 4,064,506 by Cartwright (“Cartwright”). Insofar as they may be applied against the Claims, these rejections are respectfully traversed.

Whether an invention satisfies the nonobviousness requirement under 35 U.S.C. §103 is a question of law with subsidiary factual inquiries.¹ These inquiries include the scope and content of the prior art, the differences between the prior art and the claims at issue, the level of ordinary skill in the pertinent art, and any objective indicia of nonobviousness.² A claimed invention is unpatentable if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”³ Thus, it is improper to use hindsight when determining whether the claimed invention would have been obvious at the time of the invention, and “a

¹ *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000).

² *Eisai Co. v. Dr. Reddy's Labs.*, 533 F.3d 1353, 1356 (Fed. Cir. 2008).

³ 35 U.S.C. §103(a) (2008); *see also Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966).

factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”⁴

As stated above, the relevant time frame for an obviousness evaluation under 35 U.S.C. §103 is “the time the invention was made.” This time frame guards against entry into the “tempting but forbidden zone of hindsight” in evaluating the obviousness of a claimed invention.⁵ Measuring a claimed invention against the standard established by 35 U.S.C. §103 requires “the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.”⁶ One way to identify hindsight reconstruction is the “pick[ing] and choos[ing] among isolated disclosures in the prior art to deprecate the claimed invention.”⁷ It is apparent that the Examiner has based the rejections under 35 U.S.C. §103(a) in view of the foregoing references on impermissible hindsight because the Examiner is using Applicant's disclosure to pick and choose among different disclosures in the prior art to obtain the claimed inventions.

Applicants in the previous response pointed to errors in the Examiner's analysis with respect to Claim 21. Specifically, Applicants asserted that Fuijoka does not disclose (nor is it combinable with the AAPA to disclose) “a diode-connected transistor having a voltage-temperature response similar to that of each of the first pair of emitter-follower output transistors in the first amplifier stage” because of the configuration of Fuijoka, and Applicants pointed out that the Examiner's

⁴ *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 17 (U.S. April 30, 2007).

⁵ See *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2s 861, 873, rev'd by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059 (Fed. Cir. 1998)

⁶ See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1533 (Fed. Cir. 1983).

⁷ *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

rationale for combining was completely flawed because it was contrary to the desired operation of the circuit of Claim 21.⁸ In response to these arguments, the Examiner now asserts that:⁹

from a temperature responsive unit (64-66), and an output to a third transistor connected between a supply voltage and the temperature responsive unit and a regulated voltage output locus between the third transistor (63) and the temperature responsive unit, wherein the temperature responsive unit includes in series a first resistor, a second resistor, and a diode-connected transistor. The modified prior art figure 2 further fails to show that the diode connected transistor is bipolar transistor. However, Cartwright teaches in column 5, lines 35-47, that bipolar transistors have an advantage over FET's in that their transconductances tend to be little affected by emitter-to-collector potential variations. Therefore, it would have been obvious to one having ordinary skill in the art to use bipolar transistors for Fujioka's transistors for the purpose of improving the performance of the voltage reference voltage generator. Thus, the modified prior art figure 2 further shows that the diode connected transistor having a voltage-temperature response similar to that of each of the first pair of emitter-follower output transistors in the first amplifier stage.

In particular, the Examiner now changes course and states that it would be obvious to modify Fujioka with Cartwright to “improve the performance of the voltage reference generator,” even though Fujioka expressly states at column 6, lines 35-40 that “[t]he drain and the gate electrodes of the nMOS transistor 64 are short-circuited in order to prevent the internal power-supply potential V_{ii} from changing according to ambient temperature.” This is a clear indication that the Examiner is using Applicants’ disclosure as a blueprint for these rejections.

Additionally, in anticipation of the Examiner’s counterargument in reliance on a “person of ordinary skill in the art ha[ving] good reason to pursue the known options within his or her technical

⁸ See Response dated August 13, 2008 at pages 4-8.

⁹ Office Action, page 3.

grasp” in response to market pressure or design needs as articulated by the Supreme Court in *KSR*, Applicants assert that this rationale is fatally flawed with respect to Claim 21.¹⁰ Taking this proposition in its broadest sense, all circuits would be obvious in view of a good treatise on electrical engineering, particularly one that details the properties of basic components (such as resistors and capacitors); however, this proposition is *not* infinitely broad. The Supreme Court (by making reference to hindsight) even asserted that this proposition is not infinite.¹¹ Instead, for a claim possessing sufficient detail (such as Claim 21), the boundary between obvious and non-obviousness is crossed.

Accordingly, Applicants respectfully request that the Examiner’s rejection of Claim 21 under 35 U.S.C. §103(a) be withdrawn and that Claim 21 be allowed. Additionally, Claims 22, 23, 27, and 28 depend on and further limit Claim 21. Hence, for at least the aforementioned reasons, these claims should be deemed to be in condition for allowance. Applicants respectfully request that the rejections of dependent Claims 22, 23, 27, and 28 also be withdrawn.

Conclusion

Applicants have now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 21-28.

Applicants do not believe that any fees are due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and

¹⁰ *KSR*, No. 04-1350, slip op. at 6.

¹¹ *See KSR*, No. 04-1350, slip op. at 17.

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to credit any overpayment made, in connection with the filing of this paper to Deposit Account 20-0668 of Texas Instruments Incorporated.

Should the Examiner require any further clarification to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

/John J. Patti/

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